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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/531,951	03/21/2000	Craig Douglas Voisin	57921/105	7500

7590 03/19/2003

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EXAMINER

DURAN, ARTHUR D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 03/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/531,951

Applicant(s)

VOISIN ET AL.

Examiner

Arthur Duran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-51 have been examined.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/12/03 has been entered.

#### ***Claim Rejections - 35 USC § 101***

3. Claims 32-38, 40, and 42-45 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims are rejected under 35 U.S.C. 101 because these claims have no connection to the technological arts. To overcome this rejection, the Examiner recommends that the Applicant amend the claim to specify at all or, in some cases, to better clarify that the method is utilizing a medium or apparatus, etc within the technological arts.

#### ***Response to Amendment***

4. The Amendment filed on 2/12/03 is sufficient to overcome the Lumelsky and Dedrick reference.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-5, 7-10, 13, 15, 16, 18, 20-26, 28-30, 32, 37, and 40-48 are rejected under 35 U.S.C. 102(b) as being unpatentable over Gerace, (5,848,396).

Claims 1, 16, 22: Gerace discloses maintaining an Internet-related communication session between a user and a portal (col 4, lines 1-5) and during the communication session periodically selecting and playing advertisements automatically based on any one of user constraints and sales criteria (col 2, lines 35-42; col 5, lines 8-25).

Claims 2, 23: Gerace discloses a method as in claims 1, 22, and further discloses playing an audio message identifying a product or service to be advertised, including a query as to whether the user would like to hear more information regarding the product or service, identifying a response of the user (col 2, lines 35-42; col 3, lines 4-10; col 8, lines 63-65; col 25, lines 15-17), selectively playing an audio advertisement for the product or service, if the response was affirmative (col 2, lines 40-42).

Claims 3 and 24: Gerace discloses a method and means as in claim 2 and 23, and further discloses that the step of playing an audio message is in response to a previous user selection (col 2, lines 35-42).

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Claims 4 and 25: Gerace discloses a method and means as in claims 2 and 23, and further discloses the step of playing and audio message comprises identifying a preference of the user and selecting an advertisement for a product of service which corresponds to the preference of the user (col 5, lines 15-25).

Claims 5, 18, and 26: Gerace discloses a method and means as in claims 4, 16, and 24, and further discloses identifying the user and retrieving preference information corresponding to the user, the preference information being stored in a database, and the advertisements played (col 5, lines 15-25).

Claims 7, 9, 20, 44: Gerace discloses a method as in claims 2, 8, 16, 42, and further discloses the step of selectively playing an audio advertisement which comprises defining a set of advertisements, assigning weights to each member of the set of advertisements, and selecting a member of the set of advertisements based on the assigned weight (col 14, line 65-col 15, line 12).

Claims 8, 21, 28: Gerace discloses a method as in claims 7, 16, and 23 , and further discloses that wherein the step of assigning weights to each member of the set of advertisements comprises prioritizing each member of the set of advertisements (col 14, line 65-col 15, line 12).

Claim 13: Gerace discloses a method as in claim 1 above, and further discloses that the step of maintaining a communication session between a user and portal comprises establishing a connection between a web device and the portal (col 3, lines 54-57).

Claim 15: Gerace discloses a method as in claim 1 above, and further discloses that the step of maintaining a communication session between a user and portal comprises communicating with a personal computer interface (col 2, lines 1-15; col 4, lines 1-10).

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Claim 29, 32-36, 40, 41, 42, 43, 46, 47, 48: Gerace discloses maintaining an Internet-related communication session between a user and a portal (col 4, lines 1-5) and during the communication session periodically selecting and playing advertisements automatically based on any one of user constraints and sales criteria (col 2, lines 35-42; col 5, lines 8-25).

Gerace further discloses playing an audio message identifying a product or service to be advertised, including a query as to whether the user would like to hear more information regarding the product or service, identifying a response of the user (col 2, lines 35-42; col 3, lines 4-10; col 8, lines 63-65; col 25, lines 15-17), selectively playing an audio advertisement for the product or service, if the response was affirmative (col 2, lines 40-42).

Gerace Further discloses the step of selectively playing an audio advertisement which comprises defining a set of advertisements, assigning weights to each member of the set of advertisements, and selecting a member of the set of advertisements based on the assigned weight (col 14, line 65-col 15, line 12).

Claims 10, 30, 37 and 45: Gerace discloses a system as in claims 7, 32, and 42, and further discloses providing billing information on advertisements used based on a per use rate of charge (col 12, line 56-col 13, line 10).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 6, 11, 12, 14, 17, 19, 27, 31, 38, 39, 49, 50, 51 are rejected under 35

U.S.C. 103(a) as being unpatentable over Gerace (5,848,396) in view of Lumelsky (6,246,672).

Claims 6 and 27: Gerace discloses a method as in claims 2 and 23. Gerace further discloses a wide variety of input means (col 38, lines 25-27). Gerace further discloses the user of audio and radio broadcasts (col 3, lines 4-10; col 8, lines 63-65; col 25, lines 15-17). Gerace further discloses making the use of the invention more appealing to the user (col 2, lines 47-54).

Gerace does not explicitly disclose the step of identifying a response of the user comprising applying voice recognition techniques. However, Lumelsky discloses step of identifying a response of the user comprising applying voice recognition techniques (col 12, lines 10-13).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Lumelsky's voice recognition to Gerace's targeted advertising. One would have been motivated to do this because voice recognition is a standard method of user input and allows Gerace's user's further convenience.

Claims 11, 14, 17, 19, 31, and 49: Gerace discloses a method as in claims 2, 1, 16, 23, and 46. Gerace further discloses the user making selections and purchases (col 2, lines 35-42). Gerace further discloses the user of audio and radio broadcasts (col 3, lines 4-10; col 8, lines 63-65; col 25, lines 15-17). Gerace further discloses making the use of the invention more appealing to the user (col 2, lines 47-54). Gerace further discloses warning and notice messages (col 33, lines 32-35).

Gerace does not explicitly disclose identifying a response comprises playing a confirmation audio message to confirm the response.

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Gerace does not explicitly that the communication session comprises a voice interface.

However, Lumelsky discloses identifying a response comprises playing a confirmation audio message to confirm the response (col 7, lines 15-18).

Lumelsky further discloses that the step of maintaining a communication session between a user and portal comprises communicating with a voice interface (col 8, line 66-col 9, line 1).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Lumelsky's voice recognition to Gerace's targeted advertising. One would have been motivated to do this because voice recognition is a standard method of user input and allows Gerace's user's further convenience.

Claims 12, 38, 39, 50: Gerace discloses a method as in claims 1, 32, 46. Gerace further discloses that the communication session between a user and portal can be over an Internet capable medium (col 3, lines 54-57).

Gerace does not explicitly disclose the step of maintaining a communication session between a user and portal comprises establishing a connection between a wireless application protocol device and the portal.

However, Lumelsky discloses maintaining a communication session between a user and portal comprises establishing a connection between a wireless application protocol device and the portal (col 1, lines 6-9 and col 6, lines 57-65).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Lumelsky's wireless device to Gerace's targeted advertising over the Internet. One would have been motivated to do this because wireless devices interacting with



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the Internet is an industry standard and allows Gerace's method to reach a wider spectrum of user devices.

Claim 51: Gerace discloses a program code as in claim 46 above. Gerace discloses that the program code operates audio content (col 3, lines 4-10; col 8, lines 63-65; col 25, lines 15-17). Gerace further discloses collecting and maintaining user telephone information and general telephone related information (col 1, lines 10-14; col 6, lines 1-5; col 9, lines 30-33).

Gerace does not explicitly disclose that the computer readable program code for transforming Internet-based information into speech or vocal transmission utilizes the telephone.

However, Lumelsky discloses a system with program code for an interactive radio system that utilizes the telephone (col 21, lines 53-62 and col 23, line 4).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Lumelsky's voice recognition with telephone utilization to Gerace's targeted information.

One would have been motivated to do this because so that Gerace can better utilize the telephone information that he has already collected.

### ***Response to Arguments***

7. Applicant's arguments with respect to claim 1-51 have been considered but are moot in view of the new ground(s) of rejection.

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety that is being referred to.

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***Conclusion***

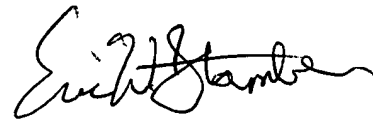
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (703)305-4687. The examiner can normally be reached on Mon- Fri, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703)305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9326 for regular communications and (703)872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

AD

March 10, 2003



**ERIC W. STAMBER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600**